IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Ulrich BEGEMANN et al.	Group Art Unit: 1792
Appln. No.	:	10/596,071	Examiner: Laura Estelle Edwards
Filed	:	May 26, 2006	Confirmation No.: 1477
For	:	PAPER MACHINE	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir :

In response to the Examiner's restriction requirement of December 17, 2008, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., January 21, 2009 (January 17, 2009 being a Saturday and January 19, 2009 and January 20, 2009 being federal holidays), Applicants hereby elect the invention of Group I, including claims 18 – 38. The above election is made with traverse for the reasons set herein below.

In the Restriction Requirement of December 17, 2008, the Examiner indicates that all claims (18 – 42) are subject to restriction under 35 U.S.C. §§ 121 and 372. The Examiner restricts the claimed invention into Group I, including claims 18 – 38, drawn to a paper machine, Group II, including claims 39 – 41, drawn to a coating machine, and Group III, including claim 42, drawn to a method.

The Examiner asserts that the inventions listed in Group I, Group II and Group III do not relate to a single general inventive concept under PCT Rule 13.1 because the Examiner asserts that, under PCT Rule 13.2, the three groups lack the same corresponding technical feature. More specifically, the Examiner asserts that the common technical feature of Group I is directed to a paper making machine including processing sections such as a wire section, pressing section, and drying section as well as a film press, calendar, and winding or reeling unit. Moreover, the Examiner asserts that the common technical feature of Group I is present at least in U.S. Patent No. 6,413,371 issued to Ahonen et al. (hereinafter AHONEN). Thus, the Examiner asserts that there is no unity of invention, as the Examiner-identified common technical feature is present in AHONEN. Applicants respectfully disagree with the Examiner's assertions.

Applicants respectfully remind the Examiner of the guidance provided regarding unity of invention at MPEP § 1893(o)(3)(d), which states: (emphasis added)

> The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. . . . The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.
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> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. . . .

Furthermore, Applicants respectfully remind the Examiner of the guidance provided regarding unity of invention at 37 C.F.R. § 1.475, which states: (emphasis added)

> (a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
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> (b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
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> (1) A product and a process specially adapted for the manufacture of said product; or
>
> (2) A product and a process of use of said product; or
>
> (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
>
> (4) A process and an apparatus or means specifically designed for carrying out the said process; or
>
> (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

In view of the above, Applicants submit that at least the Examiner-identified Groups I and III of the instant invention should be considered to have unity of invention *per se*. That is, Applicants submit that Group III is directed to a process and Group I is directed to an apparatus specifically designed for carrying out the process. Thus, Applicants submit the Examiner's assertion that the process and an apparatus or means specifically designed for carrying out the said process lack unity of invention is contrary to Rule 475, as set forth above. Therefore, Applicants submit that these claims to the different categories of invention (*i.e.,* Group I and Group III) should be considered to have unity of invention.

For all of the above reasons, the Examiner's restriction is believed to be improper. Accordingly, Applicants respectfully request that the Examiner withdraw the Restriction Requirement. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I, *i.e.,* claims 18 – 38 in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should the Examiner have any questions or comments, she is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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